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CHARLES ELMORE CROPLEY
CLERK

IN THE

Supreme Court of the United States

October Term, 1941

No. 233

FREDERIC H. PENN, doing business under the name and style of SUPERLITE COMPANY,
Petitioner,
vs.
NOVADEL-AGENE CORPORATION,
Respondent.

TEX-O-KAN FLOUR MILLS COMPANY,
Petitioner,
vs.
NOVADEL-AGENE CORPORATION,
Respondent.

REPLY BRIEF FOR PETITIONERS IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI.

SAMUEL E. DARBY, JR.,
Counsel for Petitioners.

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LOUIS D. FLETCHER.

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Respondent's brief in opposition to the grant of a writ of certiorari in this case necessitates brief comment.

I.

The issue presented by this case—viz: whether or not the public may be restrained from utilizing the invention, of an expired patent by means of a second unexpired patent subsequently issued to the same patentee for the same invention—is termed by respondent "double patenting".

Regardless of by what name the issue is termed, respondent seeks to avoid a corrective review of the case by this

Court by initially admitting (Brief, p. 2) that the issue had been raised "whimsically" in *another* litigation between *different* parties. Obviously, the wholly casual judgment of the earlier Court on this "whimsically" raised issue in the prior litigation is in no sense comparable to the *deliberate and considered* judgment of Judge ATWELL on this issue most seriously and earnestly raised and pressed in the present case. Notwithstanding this fact, however, respondent then argues that the prior judgment should not be disturbed, but should be given the practical effect of the doctrine of *res judicata,* despite the fact that not a single prerequisite to the applicability of the doctrine is here present.

Then, in apparent realization of the violence its argument does to the doctrine in view of the fact that neither of petitioners ever, in the slightest sense or to the slightest extent, were involved in the prior litigation, the assertion is made (Brief, p. 3) that "some type of privity" exists between petitioner Penn and the defendant in the prior litigation. This statement of respondent is entirely and deliberately untrue. The prior litigation terminated with the opinion of the Court of Appeals for the Second Circuit in 1929. Petitioner Penn entered this industry in 1933 (R. 151). When he had developed his product to a commercial stage he had a patent search made which revealed a Schotz patent, owned by one Kerope Gulbenkian (who, we now learn, had been a defendant in the prior 1929 litigation), and an Avedikian patent (the patentee of which, we now learn, had testified as a witness in the prior litigation). Mr. Penn individually sought out these two patent owners, who were entirely unknown to him, and acquired an exclusive license under the Schotz and Avedikian patents because he believed them to be of value to him in his enterprise. This was the first and only time he has ever had personal contact with either of

these gentlemen (R. 155, 156). Despite these simple facts, *which were in no respect disputed,* and could not have been, respondent makes the deliberate, untrue statement above quoted. This illustrates far more eloquently than argument could to what extremes respondent is prepared to go to avoid a corrective review of this case.

II.

Respondent charges (Brief, p. 4) that the petition and supporting brief are "inaccurate" as well as inadequate, but fails to point to a single inaccuracy contained in either thereof, and indeed could not do so.

The only colorable attempt in that direction is the claim that Judge ATWELL did not make a *"finding of fact"* that the two Sutherland patents were for the same invention (Brief, p. 8). That respondent is in error, even in this, will be found on reference to Finding of Fact No. 1 (R. 239), either alone, or in conjunction with the oral remarks of the Court to which the Finding directs attention (R. 237, 238).

In this portion of respondent's brief effort is made to argue the merits of the cause; and there is presented a laborious argument attempting to draw some presumed distinction between *"genus"*, *"specie"*, and *"sub-specie"* of invention, which would set the Sutherland patent in suit apart from all other patents of the United States, and enable its monopoly to continue although that *identical* monopoly had expired with the expiration of the prior patent to the same patentee, as found by the District Court. The fallacy of the contention is believed to be self evident when it is remembered that it was the *monopoly* of the expired patent —*whether broad or narrow*—that passed into the public realm upon its expiration. If, as respondent asserts, the expired patent covered and monopolized *all* organic perox-

ides, then, upon its expiration, the public acquired the right to use *all* organic peroxides. Especially is this so when, as shown by the file history of the application for the expired patent (Defendant's Exhibit 5, physical) its allowance was procured by means of demonstration and tests made with benzoyl-peroxide.* In other words, and as a fact revealed by the documentary records in flat contradiction to respondent's assertion, *it was the use of the particular organic peroxide—benzoyl-peroxide—that procured the allowance of the expired reissue patent.*

Moreover, it is quite obvious that the only difference between a patent claim which covers *all* organic peroxides, and one which specifies but *one* thereof (namely benzoyl-peroxide), is merely a difference in *scope.* Such a difference was *expressly* stated by this Court *not* to give validity to a second patent to the same patentee in *Miller* v. *Eagle Manufacturing Company,* 151 U. S. 186 at page 198:

> "* * * it must distinctly appear that the invention covered by the later patent was a separate invention, distinctly different and independent from that covered by the first patent; in other words, it must be something substantially different from that comprehended in the first patent. *It must consist of something more than the mere distinction of the breadth and scope of the claims of each patent.*"

III.

Respondent finally seeks to minimize the public importance of the case by arguing that the royalty it has levied (and seeks to continue to levy), upon the American public

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* See the argument of April 27, 1923, with comparative charts and supporting affidavits.

is "*only* about one cent per barrel of flour" (emphasis respondent's). This, indeed, is a specious argument in opposition to a petition for a writ of certiorari to secure a review by this Court of a case which puts in issue the legality or right of levying *any* tribute on the public *through sixteen hundred millers* (R. 74), particularly in connection with bread—a daily necessity of life. If, as a matter of principle, a royalty is justified at all, respondent would be in a position to levy *any* tribute it might arbitrarily set.

Conclusion.

It is submitted as quite apparent that where a litigant is compelled to go to the extremes to which respondent is driven in its brief in the foregoing respects to which we confine our comments, there indeed, must be merit in the opposing cause sufficient to warrant, for the public interest, a review by this Court of the issue in controversy.

Therefore, the grant of the petition is most earnestly urged.

Respectfully,

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